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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,951	07/14/2003	David S. Abdallah	PRIV-004/02US 307640-2030	6422
22503	7590	09/26/2008	EXAMINER	
COOLEY GODWARD KRONISH LLP			JOHNS, CHRISTOPHER C	
ATTN: PATENT GROUP			ART UNIT	PAPER NUMBER
Suite 1100				3621
777 - 6th Street, NW				
WASHINGTON, DC 20001				
		MAIL DATE	DELIVERY MODE	
		09/26/2008	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/618,951	<b>Applicant(s)</b> ABDALLAH ET AL.
	<b>Examiner</b> Christopher C. Johns	<b>Art Unit</b> 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 July 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4,6,7,21-31 and 34-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,6,7,21-31 and 34-42 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 July 2008 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

**DETAILED ACTION**

*Acknowledgements*

1. Claims 1-4, 6, 7, 21-31, and 34-42 are pending.

*Election/Restrictions*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, 6, 7, 21-28, 38, and 39, drawn to a system and method for ensuring travel privileges through biometric authentication, classified in class 705, subclass 66.
  - II. Claims 29-31, 34-37, and 40-42, drawn to a method for receive requests for travel permission information and authenticate users without using biometrics, classified in class 705, subclass 76.
3. The inventions are distinct, each from the other because of the following reasons:
4. Inventions I and II are directed to related inventions. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed differ because group I contains biometric authentication, while group II explicitly disclaims such authentication methods.
5. However, upon further examination, the Examiner has determined that broadly providing for biometric authentication versus disclaiming biometric authentication is an obvious difference

(to a person having ordinary skill in the art). Therefore, as restriction is not proper at this time, the patentability of group I falls with group II.

***Claim Objections***

6. Claims 6, 7, and 38 are objected to for usage of the functional language "configured to". It is believed that Applicants intend "configured to" to mean "programmed to" since "configured to" is functional language and therefore given less patentable weight. In light of the notice function of the claims, the Examiner respectfully requests changing "configured to" to "programmed to" where a positive recitation is desired.

7. Claim 7 is objected to as it contains the phrase "prior the travel privilege certificate". This phrase has no verb, but it is assumed that the "issuing" was not meant to be crossed out, and that the sentence should read "prior **to issuing**...".

8. Claim 22 is objected to as it contains the phrase "before the authenticating the biometric input from the user". This phrase is assumed to be "before authenticating the biometric input from the user".

9. Claims 30 and 31 are objected to as it contains the phrase "before the sending the travel...". It is assumed that this phrase should be "before sending the travel...".

10. Claims 34, 41, and 42 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Independent claim 29 notes that there is no

biometric information included in the system, yet claims 34, 41, and 42 further limit independent claim 29 as if it *did* include biometric data.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 29-31, 34-37, and 40-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In independent claim 29, it is claimed that "the request" includes "personal identity credential of the user excluding biometric information" and/or "an authentication of biometric information of the user...excluding biometric information". It would be unclear to a person having ordinary skill in the art how authentication of biometric information could possibly exclude said biometric information from the authentication process.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-4, 6, 7, 21-31, and 34-42 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent 6,085,976 ("Sehr").
15. As per claims 1-4, 6, 7, 21-31, and 34-42, Sehr teaches:
- b. institution for researching and recording identity and at least one travel privilege for individuals (figure 3, "Cardholder/Passenger Background");
  - c. database maintained by institution for associating identified individuals' names (figure 3, "Cardholder/Passenger Background"), assigned asymmetric key pair (figure 3, "Digital Signature"), at least one travel privilege (figure 3, "Selection Transport/Service")
    - i. privilege including destination restriction, date and time restriction, mode of transportation restriction (Figure 3, "Airplane Railroad Ship Other"), operator restriction, expiration date (inherent in the use of transportation tickets);
  - d. travel privilege certificate associated with travel privilege and identified individual (column 2, line 65, "traveler's permit");
  - e. personal identification device including means for authenticating identified individual based on a biometric (Abstract, "Biometrics identification of cardholders, as well as cryptographic certification of card data and travel-related information, can optionally be encoded onto the cards...");
  - f. certificate comprising name, date, time, mode of transportation, type of privilege, issue date, expiration date fields, unique serial number, and a digital signature created by issuer of certificate (column 15, lines 15-37 - "electronic representation of tickets...seat assignments...carrier...date and time...unique ticket number...name and address...selected information about the carrier or itinerary"; column 31, lines 19+ -

- "public key technology...can also be used to store a public key certificate in the passenger card");
- g. modes of transportation include train, bus, car, airplane, or ship (column 7, lines 45-47 - "airplanes, railroads, ships, automobiles, subways, buses, or rental cars");
- h. type of privilege includes reservation ticket, boarding pass, port-of-entry permission, vehicle operator permission (column 7, lines 47-53 - "reservations...electronic ticketing...transportation support");
- i. means for communicating configured to download travel privilege certificate to said personal identification device, download a computing mechanism onto the personal identification device, download a digital certificate and asymmetric key pair for the individual into the personal identification device, and transmit at least one travel privilege certificate from said personal information device (column 6, lines 39-51 - "write information into the card"; column 19, lines 3-5 - "Read/Write means refer to the retrieving of data from or the loading of data into the passenger card"; figure 1, reference number 12);
- j. means for recording at least one notable event on said personal identification device (column 30, line 55 - "audit trail about the data and information stored in the card, authentications and verifications...");
- k. means for storing at least one travel privilege certificate on said personal information device (Abstract, "cards so as to automatically compile...store and activate a traveler's permit for transportation and other travel service");

- l. at least one application audit log on said personal identification device (column 30, line 55 - "audit trail");
- m. means for receiving the biometric of the identified individual prior to the identified individual being authenticated based on the biometric and prior the travel privilege certificate;
- n. receiving the biometric input from the user before the authenticating the biometric input from the user (inherent in the operation of any computer, as in order to authentication information it must be received), the biometric input being at least one of a fingerprint information of the user (column 6, line 54), a retinal information of the user (column 6, line 54), and an image information of the user (column 6, lines 54 and 55);
- o. sending an admission ticket information associated with the travel permission information when the biometric input form the user is authenticated at the personal identification device (column 13, lines 15-20);
- p. travel permission information includes at least one of a time, mode of transportation, destination, date, operator, or expiration date restriction (column 17, lines 33-42; expiration dates are inherent in the art of travel permissions and certificates);
- q. receiving a request for a travel permission ...including at least one of a personal identity credential of the user excluding biometric information (Abstract, "Biometrics information of cardholders...can optionally be encoded") or an authentication of the biometric information of the user performed at the personal identification device, the authentication excluding biometric information;

- r. producing the travel permission information based on the personal identity credential of the user before the sending the travel permission (column 18, lines 37-56 - "such an authorization may be achieved...via a PIN or any other password-like information the entities have to provide before the read/write operations can be performed");
- s. portable and is configured to be used when transported (Abstract, "process the portable passenger cards");
- t. receiving from the personal identification device a second authentication of the biometric information of the user when the user is operating a vehicle, performed at device and excluding biometric information (column 37, lines 8-51 - "card-based key can be used...to start the ignition of the rental car...").

***Claim Rejections - 35 USC § 103***

- 16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
- 17. Claims 1-4, 6, 7, 21-31, and 34-42 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Sehr in view of "Practical Traveler; Airline Tickets as Presents", a story from the New York Times, 21 September 1997 ("Wade").

u. It is the examiner's primary position that the claims are anticipated because of the above inherent features (i.e. expiration of travel privileges)<sup>1</sup>. However, if not inherent, then Wade teaches airline tickets that expire (¶8). Plane tickets (as well as frequent flier miles and awards) expire in order to limit competition and sales of tickets by other vendors, and guarantee a steady flow of income to the issuing parties. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement expiration dates on tickets and other items of value, as it creates a steady flow of income for the ticket issuers, something that a person having ordinary skill in the art would understand as advantageous because of the financial advantages.

*Response to Arguments*

18. Applicants' arguments with respect to the previous have been considered but are moot in view of the new ground(s) of rejection.
19. As per Applicants' arguments concerning a multiple reference rejection under 35 U.S.C. 102(b), the Examiner notes that MPEP §2131.01 authorizes such rejections.

*Conclusion*

20. **Examiner's Note:** Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to

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<sup>1</sup> MPEP §2112.III authorizes a rejection under 35 USC §102 as well as 35 USC §103, when the "the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference". While the Examiner feels that the prior art exactly discloses the claimed invention, a §103 rejection has been made in order to expedite prosecution.

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specific limitations within the individual claim and other passages and figures may apply as well.

It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Furthermore, it must be noted that the documents cited on any enclosed PTO-892 or PTO-1449 form are cited in their entirety.

21. Applicants' amendment filed June 17, 2008 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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23. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

24. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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